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REMARKS

The present response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicants assert that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-27 are pending in the application. Claims 1-13, 17, 18 and 21-27 have been rejected. Claims 14-16 and 19-20 have been withdrawn. Claims 1 and 24-26 have been canceled. Applicants reserve all rights in these claims to file divisional and/or continuation patent applications. Claims 2, 17-18, 21-23 and 27 have been amended.

New claim 28 has been added in order to further define what the Applicants consider to be the invention. Applicants respectfully assert that no new matter has been added.

Remarks to the Specification

The amendments to the specification are editorial in nature and do not introduce new matter.

CLAIM REJECTIONS

35 U.S.C. § 112 Rejections

In the Office Action, the Examiner rejected claims 1-13, 17, 18, and 21-27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, according to the Examiner, in claim 1, line 1, the method is cited as being an "automated method", however, in contrast, none of the specific steps in claim 1 indicate any automation practice. Thus, the Examiner asserts that the claim is vague and indefinite as

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to whether the phrase "automated method" in line 1 or the specifically cited claim steps without any automation requirement control the metes and bounds of the claim practice. Also, the Examiner asserts that the claim is not clear as to whether automation in line 1 is inclusive of all steps performed in the practice of claim 1 or whether such automation may be directed only to one step and not others.

According to the Examiner claim 2 also contains the above unclarities, clarification via clearer claim wording was requested for claim 2 as well as for claims which depend directly or indirectly from claims 1 or 2.

Applicants assert that claim 1 has been canceled, rendering the Examiner's rejection of claim 1 moot. Claim 2 has been amended to include the term "automatically" in each step and therefore overcome the antecedent basis deficiencies noted by the Examiner regarding claims 2 and 3-13, 17, 18, and 21-23, which depend thereon.

According to the Examiner, claim 27 cites the identifying of "families of molecules" in line 1, however, lacks any families limitation as being identified in steps a) or b). As noted by the Examiner, in the last 2 lines of claim 27 the classification of similar function molecules is cited but without stating that such similar molecules are what are meant by the families of line 1. The Examiner suggested that the similar molecules in the last 2 lines of claim 27 may be assumed to be the families of line 1 of the claim, however, asserted that such an assumption is not a clear and concise claim practice as required under 35 U.S.C. § 112, second paragraph.

In response, claim 27 has been amended as per the Examiner's suggestion to comply with the requirements of 35 U.S.C. § 112, second paragraph.

In addition, according to the Examiner, in claim 1, line 5, the phrase "the position of a selected molecule" is set forth but without clear antecedent basis as to what is meant regarding "position". There is no physical position defined nor a database position defined in the claim. The Examiner suggested that it may be assumed that the position is meant to define a database location, however, such an assumption is not a clear and concise claim practice as required under 35 U.S.C. § 112, second paragraph. This unclarity is also present in instant claim 2, part b), first line therein. Clarification via clearer claim wording is requested.

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Claims which depend directly or indirectly from claims 1 or 2 also contain this unclarity due to their dependence.

Applicants assert that claim 1 has been canceled, rendering the Examiner's rejection of claim 1 moot. Claim 2 has been amended as per the Examiner's suggestion to clarify the term "position" in order to comply with the requirements of 35 U.S.C. § 112, second paragraph.

In addition, according to the Examiner, in claims 24-26 thresholds are cited as numerical values, however, such values are deemed comparative values and lack antecedent basis as to what comparative values are meant corresponding to the specific numerical values in said claims 24-26. Clarification via clearer claim wording is requested as to what is compared to result in evaluating the threshold values of instant claims 24-26.

Applicants canceled claims 24-26, rendering the Examiner's rejection of claims 24-26 moot..

It is respectfully asserted that the foregoing amendment merely addresses matters of form and does not change the literal scope of the claim in any way or result in any prosecution history estoppel.

Applicants respectfully assert that these amendments render claims 2, 3-13, 17, 18, 21-23 and 27 proper under 35 USC 112 and request that the rejections be withdrawn.

35 U.S.C. § 102 Rejections

In the Office Action, the Examiner rejected claims 1,17,18, and 22 under 35 U.S.C. § 102(b), as being anticipated by [Protein Science 7:233-242 (1998)].

In addition, the Examiner rejected claims 1,17,18, 21, and 22 under 35 U.S.C. § 102(b), as being anticipated by either of Levitt et al. [Nature 261:552-558 (1976)] or Orengo et al. [Protein Engineering 6(5): 485-500 (1993)].

Applicants have herein canceled claim 1, rendering the Examiner's rejection of claim 1 moot. Claims 17, 18, and 22 have been amended to depend from claim 2. Since neither of [Protein Science 7:233-242 (1998)], [Nature 261:552-558 (1976)] and [Protein Engineering 6(5): 485-500 (1993)] anticipate claim 2, Applicants request withdrawal of the rejection of claims 17,18, and 22, which depend from claim 2.

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35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 27 under 35 U.S.C. § 103(a), as being unpatentable over [Protein Science 7:233-242 (1998)].


Applicants amended claim 27 to include the automatically classification_details. Accordingly, Applicants request the withdrawal of the rejection of claim 27.

In view of the foregoing amendments and remarks, the pending claims are deemed to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Should the Examiner have any question or comment as to the form, content or entry of this Amendment, the Examiner is requested to contact the undersigned at the telephone number below. Similarly, if there are any further issues yet to be resolved to advance the prosecution of this application to issue, the Examiner is requested to telephone the undersigned counsel.

Please charge any fees associated with this paper to deposit account No. 05-0649.

Respectfully submitted,



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